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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,664	02/11/2002	Lorin C. Nash	19789-10	4604

24256 7590 05/12/2003

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EXAMINER
LE, HOA VAN

ART UNIT	PAPER NUMBER
1752	12

DATE MAILED: 05/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/073,664	NASH ET AL.	
	Examiner	Art Unit	
	Hoa V. Le	1752	

-- The MAILING DATE of this communication app ars on the cover sh t with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *03* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 May 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-62* is/are pending in the application.

4a) Of the above claim(s) *17-62* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-62* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

This is in response to the Election filed on 05 May 2003.

I. Applicants elect (1) an aqueous color developing solution and (2) thickening additive with traverse being acknowledged. The traversal is on the ground that "it is not necessary for examination of the present claims to require species election. Each of species election requirements has each own major search class which would be properly restricted out if each of them is presented in a separate and independent claim. An additional search is burdensome.

II. Applicants` prior art submissions filed on 11 June 2002 and 14 February 2003 have been considered.

III. Applicants` election of the species on the record has been considered and searched. The consideration and search are extended to the applied species in the applied references. Other non-elected species have not been considered, searched or examined until all of the elected and applied species are overcome.

IV. (1) It is allowed to claim by a functional, characteristic, physical and/or chemical property of a material and /or process (In re Swinehart, 169 USPQ 226). (2) However, a claimed functional, characteristic, physical and/or chemical property of a material and/or process carries with a risk (In re Swinehart, 169 USPQ 228). Therefore, one should be carefully looked into it for his own benefit. Please also see In re Schreiber, 44 USPQ2d 1432 since it is reasonable that

the Office is not supplied, provided or equipped with a sufficient facility to carry out a test for the functional, characteristic, physical and/or chemical properties as claimed in accordance with the authority stated in In re Best, 195 USPQ 430; Ex parte Maizel, 27 USPQ2d 1662 or Ex parte Phillip, 28 USPQ2d 1302. The language "developing agent", "surfactant", "thickener", surface tension...30 dynes/cm", "viscosity...30,000 cP", "buffered solution...pH...about 8", "activator", "restrainer", "preservative", "antifoggant", "accelerator", "non-Newtonian fluid" or the like is considered as the functional, characteristic, chemical and physical property of a material.

(2) Within the authority of the Office being granted by the authority in the court of law, applicant is required to show or provide an evidence to the contrary to the applied material and process from the applied reference for the claimed property of the material and process as claimed for its patentability in accordance with the authority stated in In re Swinehart, 169 USPQ 228. It is should be noted that an argument alone (1) would be taken a place of an objective evidence as a matter of law (2) has and (3) is given a little to no value.

V. (A) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Claims 1-16 with respect to the elected species and applied are rejected under 35 U.S.C. 102(b) as being anticipated by Hilton et al (3,615,496).

Hilton et al disclose, teach, suggest, demonstrate and reduce to practice with an aqueous silver halide color developing solution comprising a color developing agent as elected and a thickening agent as elected. Please see the whole disclosure of the applied reference, especially at the Examples. Since Hilton et al disclose, teach, suggest, demonstrate and reduce to practice

with the claimed invention using the elected species, the above applied claims are found to be anticipated by Hilton et al.

(B) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-16 with respect to the elected and applied species are rejected under 35 U.S.C. 103(a) as being unpatentable over Hilton et al (3,615,496).

The basic for the rejection is essentially the same as that in paragraph "V. (A)" above with an addition that compounds are not used in the Examples but disclosed, taught and suggested in Hilton et al at col.45 to 3:36 are found to be obvious variants and conventional additives in the photographic art as disclosed, taught and suggested by Hilton et al. Applicants should show or provide an evidence to the contrary

VI. (A) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

Claims 1-16 with respect to the elected species and applied are rejected under 35 U.S.C. 102(b) as being anticipated by Hashimoto et al (5,891,608).

Hashimoto et al disclose, teach, suggest, demonstrate and reduce to practice with an aqueous silver halide color developing solution comprising a color developing agent as elected

and a thickening agent as elected. Please see the whole disclosure of the applied reference, especially at the Examples. Since Hashimoto et al disclose, teach, suggest, demonstrate and reduce to practice with the claimed invention using the elected species, the above applied claims are found to be anticipated by Hashimoto et al.

(B) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-16 with respect to the elected and applied species are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto et al (5,89,608).

The basic for the rejection is essentially the same as that in paragraph "VI. (A)" above with an addition that compounds are not used in the Examples but disclosed, taught and suggested in Hashimoto et al at col.2:46-51, 3:29 to 17:50, 18:23-32, 11:5-10, 19:15 to 22:35 and 66 to 25:24 are found to be obvious variants and conventional additives in the photographic art as disclosed, taught and suggested by Hashimoto et al. Applicants should show or provide an evidence to the contrary

VII. Kokeguchi et al (6,555,300) is cited to show the state of the art,

IX. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 703-308-2295. The

examiner can normally be reached on 6:30AM-5:00PM, M-TH.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone number of the examiner is 703-746-7172..

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
09 May 2003

HOA VAN LE
PRIMARY EXAMINER
Hoa Van Le